

REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amended claims and remarks made herewith, which place the application into condition for allowance.

I. Status of the Claims and Formal Matters

Claims 1-9 are pending in this application. Claim 9 has been withdrawn for allegedly being drawn to a non-elected invention. New claim 10 has been added. Applicants assert the right to file divisional applications to pursue non-elected subject matter.

No new matter is added. Support for the amended recitations and new claim 10 can be found throughout the specification.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims are and were in full compliance with the requirements of 35 U.S.C. §112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103, or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. Rejections under 35 U.S.C. §112, second paragraph are overcome

Claims 1-8 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

Specifically, the Office Action takes issue with the term “derivatives”, which was deemed to be open-ended and allegedly indefinite. The amendments to the claims, submitted herewith, now recite a “compound”.

Further, the Office Action alleges that it is unclear whether these claims are directed to a mixture of compounds or a single compound and recommends that the claims be amended to the single/alternative format. To this end, the claims have been amended to recite “An isoxazolopyridone compound of a formula...”

The term "heteroaryl" was allegedly unclear because the size, the number and type of heteroatoms, as well as the number of rings, were unclear. The amendments to the claims now recite the heteroaryl rings used in the invention.

The term "substituted" was allegedly unclear because it embraces substituents not described or known at the time of the invention. The claims are now amended to recite the substituents used in the invention.

In view of the foregoing, reconsideration and withdrawal of the rejections under 35 U.S.C. §112, second paragraph are respectfully requested.

Rejections under 35 U.S.C. Rejections under 35 U.S.C. 102(b)

Claim 1 was rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Denzer (U.S. Patent No. 4,113,727). The Office Action alleges that the compound of Example 4 and the compounds (m), (r), (s), and (t) of Denzer are encompassed by instant claim 1.

Claim 1 was also rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Nadelson I (U.S. Patent No. 4,064,251). The compounds of Example 3a and 3b of Nadelson I are allegedly encompassed by instant claim 1.

Claims 1 and 5 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Nadelson II (U.S. Patent No. 4,049,813). The compounds (a) – (e) of Example 4, and the compounds (a) – (i) of Example 5 of Nadelson II are encompassed by instant claim 1. Further, compound (c) of Example 4 and compound (c) of Example 5, having 3-(p-anisyl) are allegedly encompassed by instant claim 1.

These rejections are respectfully traversed in view of the amendments to the claims. The Office Action of February 17, 2005 stated that the compound, wherein R1a is not phenyl, would be allowable over the prior art. Denzer, Nadelson I, and Nadelson II only teach phenyl as R1a. Further, the Office Action also stated that there is no motivation to replace the prior art phenyl with another ring, such as pyridyl, to arrive at the instant invention.

Consequently, the amendments to the claims, made herewith for the purposes of advancing prosecution, now recite R1a as an optionally-substituted heteroaryl group. Reconsideration and withdrawal of the rejections under §102(b) is therefore respectfully requested.

Rejections under 35 U.S.C. §103(a)

Claim 6 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Denzer. Denzer allegedly discloses a substituted isoxazolo[4,5-c]pyridine-4-(5H)-ones useful as a hypolipidemic agent. Denzer also allegedly discloses a specific compound in Example 4 (col. 6 of Denzer), however does not expressly claim a methoxy substituent on the phenyl ring. The Office Action contends that it would have been obvious to one of skill in the art to replace the hydrogen with the alternative methoxy as taught by Denzer to arrive at the instant invention, with a reasonable expectation of obtaining an additional hypolipidemic compound. This rejection is respectfully traversed.

In the Office Action of February 17, 2004, it was stated that instant claim 6 would be allowable over Denzer if R1a were not phenyl. The amendments to the claims, which now define R1a as a heteroaryl ring, are believed to overcome the rejections under §103(a). Reconsideration and withdrawal of the rejection is therefore respectfully requested.

Rejections under 35 U.S.C. §102(e)

Claims 1 and 8 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Hintermann (WO 2003015790), which carries a filing date of August 14, 2002. The compounds of Examples 1, 3, and 5-8, as well as the compound of claim 4 described by Hintermann, is allegedly encompassed by instant claims 1 and 8. This rejection is respectfully traversed.

The Office Action states that Applicants cannot rely upon the foreign priority papers to overcome this rejection, because a translation of said papers has not been made of record in accordance with 37 C.F.R. 1.55. The instant application is a continuation-in-part of PCT/JP/05898 (WO02/102807), which was published in Japanese.

Applicants respectfully submit a certified translation of PCT/JP/05898 (WO 02/102807), filed on June 13, 2002. PCT/JP/05898 claims priority from Japanese Application No. JP2001-179801, and which carries a filing date of June 14, 2001. Consequently, Hintermann, filed on August 14, 2002, cannot be used as prior art under the provisions of §102(e).

In view of the foregoing, reconsideration and withdrawal of the rejections under §102(e) are respectfully requested.

Rejections under 35 U.S.C. §102(a)

Claims 1 and 8 were rejected under 35 U.S.C. §102(a) as allegedly being anticipated by Hintermann, which was published on February 27, 2003. The Office Action alleges that the publication date of Hintermann pre-dates the instant filing date of December 10, 2003. Further, the compounds disclosed in Hintermann (Examples 1, 3, 5-8, claim 4) are encompassed by instant claim 1. Additionally, the Hintermann compound of Example 2 is encompassed by instant claims 1 and 8.

The Office Action states that Applicants cannot rely upon the foreign priority papers to overcome this rejection, because a translation has not been made of record in accordance with 37 C.F.R. 1.55. The instant application is a continuation-in-part of PCT/JP/05898 (WO02/102807) and published in Japanese.

Applicants hereby submit a certified translation of PCT/JP/05898, filed on June 13, 2002 and claiming priority from Japanese Application No. JP2001-179801, with a filing date of June 14, 2001. Respectfully submitted, Hintermann cannot be used as §102(a) prior art in view of the translated PCT/JP/05898. Reconsideration and withdrawal of the rejections under §102(a) is therefore respectfully requested.

REQUEST FOR INTERVIEW

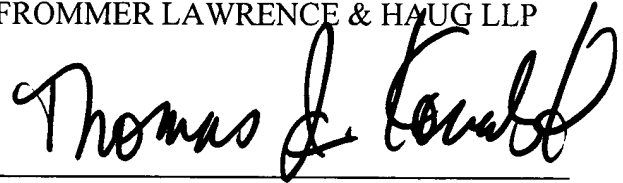
If any issue remains as an impediment to allowance, an interview with the Examiner is respectfully requested, prior to issuance of any paper other than a Notice of Allowance; and, the Examiner is respectfully requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview.

CONCLUSION

This application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By:

A handwritten signature in black ink, appearing to read "Thomas J. Kowalski", written over a horizontal line.

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